

REMARKS

Reconsideration of this application is respectfully requested in light of the amendments and remarks made herein. Claims 1-16, 18-24, 26, 28-30, 34-42 and 44-50 are amended herein. Claims 17, 25, 27, 31-33 and 43 are canceled without prejudice. New claims 51-57 are presented for examination.

Applicant has made minor amendments herein to claims 1-16, 18-24, 26, 28-30, 34-42, 44-50 to voluntarily correct certain instances of antecedent basis errors and clarify the claimed invention. Furthermore, Applicant voluntarily submitted minor amendments to the specification and figures in response to the Examiner's request to review the application for any errors in a SUPPLEMENTAL AMENDMENT, filed January 10, 2006. No new matter is added by virtue of any of these amendments.

In brief, the present claimed invention is directed to a data cartridge magazine for use in a magazine-based data cartridge library. The data cartridge magazine comprises a box structure with an interior space for accommodating a plurality of data cartridges. The box structure's interior space is defined by interior surfaces comprised by a bottom wall and side wall. Data cartridges can be inserted into and extracted from the interior space of the magazine through a top opening in the interior space defined by a terminal edge of the side wall. The terminal edge of the side wall is the edge that extends from the bottom wall from where the side wall is attached. The magazine further comprises a plurality of partitioning structures for dividing the interior space into a plurality of slots each capable of accommodating a data cartridge. The magazine is capable of being moved within the library, such as to and from a storage location, via a magazine transport means associated with the library.

Rejections Under 35 U.S.C. § 102

Claims 25, 26-28, 30-31, 33 and 43 stand rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 5,818,723 to Dimitri (hereinafter referred to as "Dimitri ('723)"). Claims 25, 27, 31, 33 and 43 are canceled herein without prejudice, obviating the rejection of these claims. Applicant may pursue the subject matter of these claims in this or other related applications. Claims 26, 28, 30 are amended herein to depend from new claim 51 and are, therefore, outside the scope of the § 102 rejection over Dimitri ('723).

Nonetheless, out of an abundance of caution, Applicant distinguishes any potential applicability of Dimitri ('723) to new claim 51 (and therefore, indirectly, any potential applicability of Dimitri ('723) to dependent claims 26, 28, and 30).

Dimitri ('723) is directed to a quick access data storage library with backup capability featuring bins for supporting magazines containing data storage media. Each of the magazines comprises a side wall with slots each adapted to hold a storage disk medium. The disk medium is adapted to be disposed in the magazine through both the front and back openings in the magazine (see FIG. 3). The storage disk medium can be inserted in or withdrawn from front open sides of the bins by a front magazine picker or inserted in or withdrawn from back open sides of the bins by a back magazine picker. The magazines can be moved to drives by a transport assembly whereby storage media can be transported from the magazines to the drive.

In contrast, as recited in new independent claim 51, Applicant's magazine comprises "a frame structure comprising a closed-loop side wall which extends to a terminal edge from an end attached to a bottom surface wherein said frame structure defines an interior space; a top opening to said interior space defined by said terminal edge where through data cartridges are capable of being inserted and extracted..." Because Dimitri ('723) fails to disclose a magazine with a closed-loop side wall and an attached bottom surface adapted for insertion and extraction of a data cartridge along one path in one opening, it is clear that Dimitri ('723) does not anticipate claim 51, and Applicant respectfully submits that claim 51 is allowable.

Dependent claims 26, 28 and 30, each depend directly or indirectly from independent claim 51 and are distinguishable over Dimitri ('723) at least for the same reasons as set forth above. Therefore Applicant respectfully submits that claims 26, 28 and 30 are also allowable.

Rejections Under 35 U.S.C. § 103

As an initial matter, Applicant notes that the use of hindsight to create a prior art combination for obviousness purposes is impermissible. Equally impermissible is combining prior art without a shown of a motivation on the part of one of ordinary skill in the art to do so.

1. Dimitri ('723) In View Of Dimitri ('464)

Claims 29, 32, 34, and 44-50 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Dimitri ('723) in view of U.S. Patent No. 5,729,464 to Dimitri (hereinafter referred to as "Dimitri ('464)"). Claim 32 is canceled herein without prejudice, obviating the rejection of this claim. Applicant may pursue the subject matter of claim 32 in this or other related applications.

Dependent claims 29, 34, and 44-50 each depend directly from new independent claim 51 which, as discussed above, is distinguishable over Dimitri ('723). The combination of Dimitri ('723) and Dimitri ('464) still does not disclose every element recited by Applicant's new independent claim 51. Even assuming, *arguendo*, that the Examiner's combination of Dimitri ('723) and Dimitri ('464) is proper, and assuming that the Examiner's contention regarding the combined disclosure of Dimitri ('723) and Dimitri ('464) is accurate, the proffered combination still fails to teach or suggest each element of independent claim 51, such as a magazine with a closed-loop side wall and a bottom surface adapted for insertion and extraction of a data cartridge along one path in one opening, and thus cannot render dependent claims 29, 34, and 44-50 obvious. Applicant thus respectfully submits that claims 29, 34, and 44-50 are allowable.

2. Dimitri ('723) In View Of Searle

Claims 1-7 and 17 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Dimitri ('723) in view of U.S. Patent No. 5,235,474 to Searle (hereinafter referred to as "Searle").

According to the Examiner, "Dimitri [('723)] does not disclose a base of the magazine. Dimitri [('732)] discloses that the magazines have baseless for loading the disks/cartridges at the both sides of the openings." The Examiner asserts that Searle makes up for the deficiencies of Dimitri ('723) when, according to the Examiner, "Searle discloses a storage unit 10 having a magazine 20 including a base 22 and side walls including a plurality of portioning structures 158's for dividing the magazine into a plurality of slots 24's; wherein the side walls terminal edges defines a top opening for the insertion/extraction of data cassettes 26's". The Examiner further asserts that "[i]t would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the magazines of Dimitri [('732)] to have a base (only one insertion/extraction direction) as set forth, as taught by Searle to reduce from two sided cartridge insertion/extraction and reduce to one cartridge

insertion/extraction dimension...”

Applicant’s claimed invention is directed to a data cartridge magazine having a box structure that has a bottom and side wall wherein the terminal edge of the side wall forms an opening to the interior space of the box structure where through data cartridges can be inserted/extracted as recited in claim 1, “the data cartridge magazine comprising: a box structure with an interior space for accommodating a plurality of data cartridges; wherein said box structure comprises a bottom wall with a bottom wall interior surface and a bottom wall exterior surface; wherein said box structure comprises a side wall that is operatively attached to said bottom wall, extends from said bottom wall to a side wall terminal edge, and has a side wall interior surface and a side wall exterior surface; wherein said bottom wall interior surface and said side wall interior surface define said interior space; wherein said side wall terminal edge defines a top opening for the insertion/extraction of data cartridges into/from said interior space...”

Neither Dimitri (‘723) or Searle disclose an opening in a box structure formed from a terminal edge as disclosed in Applicant’s claim 1. The Examiner relies on the magazine structure disclosed in Searle to make up for the deficiencies in Dimitri (‘723); however, contrary to the Examiner’s assertions, Searle does not have, “side wall terminal edges [which] defines a top opening for the insertion/extraction of data cassettes 26’s.” As shown in FIG. 3 and 4, Searle’s magazine has a bottom and three sides and does not define a top opening as the Examiner claims. Searle’s magazine receives cartridges from the side, where there is no wall, and cartridges extend out of the top of the magazine. Furthermore, Examiner asserts Searle teaches one insertion/extraction dimension, “...to have a base (only one insertion/extraction direction) as set forth, as taught by Searle...” This is an incorrect conclusion. In fact, Searle’s magazine is capable of receiving a data cartridge from the top and the side as shown in FIG. 4. Hence, neither Dimitri (‘723) or Searle teach or suggest a magazine structure that is a box structure with an opening defined by a side wall terminal edge for receiving a data cartridge from only one direction. Because Dimitri (‘723) and Searle do not disclose every element recited by Applicant’s claim 1, the proposed combination fails to teach or suggest Applicant’s claimed invention and thus Applicant respectfully submits that claim 1 is allowable.

Claim 2-7 and 17 stand rejected under 35 U.S.C. §103(a) as being unpatentable over

Dimitri ('723) in view of Searle. Dependent claim 17 is canceled herein without prejudice, obviating the rejection of this claim. Applicant may pursue the subject matter of claim 17 in this or other related applications.

Dependent claims 2-7 depend directly from independent claim 1, which as previously discussed, is distinguishable over Dimitri ('723) and Searle. Assuming *arguendo* that Dimitri ('723) and Searle are properly combinable, the combination of Dimitri ('723) and Searle still fails to disclose every element recited by applicant's claim 1. As such, the combination of those references cannot render dependent claims 2-7, all of which depend from claim 1, obvious. Applicant thus respectfully submits that claims 2-7 are allowable.

3. Dimitri ('723) In View Of Searle And Dimitri ('464)

Claims 8, 18-24 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Dimitri ('723) in view of Searle and further in view of Dimitri ('464). Dependent claims 8, 18-24 depend directly from independent claim 1, which, as previously discussed, is distinguishable over Dimitri ('723) and Searle. The combination of Dimitri ('723) and Searle still does not disclose every element recited by applicant's claim 1. Even assuming, *arguendo*, that the Examiner's combination of Dimitri ('723) and Searle is proper, and assuming that the Examiner's contention regarding the combined disclosure of Dimitri ('723) and Searle is accurate, the proposed combination fails to teach or suggest each element of Applicant's magazine of independent claim 1 and thus cannot render dependent claims 8, 18-24 obvious. Applicant thus respectfully submits that claims 8, 18-24 are allowable.

Claim Objections

According to the Office Action, claims 9-16 and 35-42 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Dependent claims 9-16 depend from independent claim 1 which distinguishes over Dimitri ('723) in view of Searle for the same reasons as set forth above and therefore applicant submits claims 9-16 are allowable as dependent from claim 1.

Dependent claims 35-42 depend from new independent claim 51, which distinguishes over Dimitri ('723) for the same reasons as set forth above. Therefore, applicant submits

claims 35-42 are allowable as dependent from new independent claim 51.

Claims 1-24 stand objected to for antecedent basis informalities. The required corrections have been made.

New Claims Presented Herein

New claim 51 features a data cartridge magazine with “a frame structure comprising a closed-loop side wall which extends to a terminal edge from an end attached to a bottom surface wherein said frame structure defines an interior space; a top opening to said interior space defined by said terminal edge where through data cartridges are capable of being inserted and extracted...” This feature is described in the specification paragraph [0103] and in claim 1. None of the prior art of record, including Searle, appears to describe, teach, or suggest the invention of claim 51, and thus this claim is allowable.

New claim 52 features a method for using a data cartridge magazine in a library of “inserting a data cartridge in one of a plurality of accommodating slots comprised by said magazine through an opening in said magazine wherein said magazine comprises a base attached to a closed loop wall and wherein said magazine is only capable of receiving said data cartridge from one direction; transporting said magazine within said library ...” These features are exemplified in FIGS. 12A-17 of the drawings and described in associated text of the specification of the present invention, and thus no new matter is added by the presentation of new claim 52. New claims 53-57 each depend directly from independent claim 52. None of the prior art of record, including Searle, appears to describe, teach, or suggest the inventions of claims 52-57, and thus these claims are allowable.

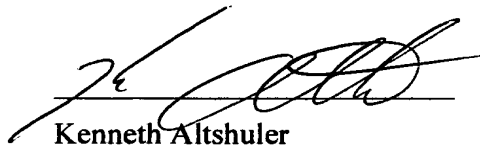
* * *

Authorization To Charge Necessary Fees

The Commissioner is hereby authorized to charge any additional necessary fees associated with this submission, or credit any overpayment, to Deposit Account No. 50-0289.

Respectfully submitted,

Dated: 1/10/06


Kenneth Altshuler

Reg. No. 50,551

Correspondence Address

WALL MARJAMA & BILINSKI LLP
101 South Salina Street, Suite 400
Syracuse, New York 13202
Telephone: (315) 425-9000
Facsimile: (315) 425-9114

Customer No.: 20874

PATENT TRADEMARK OFFICE